

REMARKS

I. Status of the Claims

Upon entry of this amendment, claims 9-17 and 19-25 and 28-37 are pending.

Claims 18, 26 and 27 have been canceled without disclaimer or prejudice. The subject matter from these claims has been folded into claims 9, 10 and 12, respectfully, by amendment (see below).

Claims 9 and 12 have been amended to specify that the claimed film has a heat shrinking ratio upon immersion in hot water at 80°C for 10 seconds of 20% or more in the main shrinking direction of the film. Support for this amendment can be found throughout the original specification as published (US 2007/212539), *e.g.*, at page 9, paragraph [0109]; page 10, paragraph [0127]; and page 11, paragraph [0131] (which provides a definition for “main shrinking direction”). Thus, no new matter is added by this amendment.

Claims 9, 10, and 12 have been amended to specify that the claimed film contains at least 5 layers, and also to specify that the arrangement of layers is either (I) layer/(II) layer/(III) layer/(II) layer/(I) layer or (I) layer/(III) layer/(II) layer/(III) layer/(I) layer. Support for these amendments can be found in the original specification as published at, *e.g.*, page 10, paragraph [0123]; and in Example 4, page 17, paragraphs [0232]-[0235], and also in original claim 18. Thus, no new matter is added by these amendments.

All amendments herein are made without prejudice or disclaimer as to all deleted subject matter. Applicants specifically reserve the right to pursue all deleted subject matter in one or more divisional and/or continuation application.

II. Rejection under 35 U.S.C. § 112, second paragraph

Claims 9 and 12 stand rejected as allegedly indefinite. Claims 13-23, 25, 27, 29, 31, 33, 35 and 37, by virtue of their dependence from claims 9 or 12, are also rejected as indefinite.

According to the Examiner, it is unclear which direction is referred to in the limitation “heat shrinking ratio upon immersion in hot water at 80°C for 10 seconds of 20% or more in at least one of the directions,” which is recited in claims 9 and 12.

In response, the Applicants have amended claims 9 and 12 to specify that the direction of the shrinkage alluded to in those claims is “the main shrinking direction of the film.” Applicants note that the language “the main shrinking direction of the film” is defined in the specification at page 11, paragraph [0131].

On the basis of the amendments to claims 9 and 12, described above, the Applicants contend that claims 9, 12-23, 25, 27, 29, 31, 33, 35 and 37 are definite and thus satisfy the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, this rejection should be withdrawn.

III. Claim rejection under 35 USC § 102(b)

Claims 9-16, 19-25 and 28-37 have been rejected by the Examiner as being anticipated by Satani et al. (EP 1 270 203) (“Satani”).

Applicant respectfully traverses this rejection.

As stated above, independent claims 9, 10, and 12 have been amended to specify that the claimed film contains at least 5 layers, and also to specify that the arrangement of layers is either (I) layer/(II) layer/(III) layer/(II) layer/(I) layer or (I) layer/(III) layer/(II) layer/(III) layer/(I) layer.

Satani does not describe heat-shrinkable polyolefin films that contain 5 layers, or 5 layer films having either layer arrangement ((I) layer/(II) layer/(III) layer/(II) layer/(I) layer or (I) layer/(III) layer/(II) layer/(III) layer/(I) layer) called for in claims 9, 10 and 12. At least for this reason, Satani cannot anticipate claims 9, 10 or 12, because it does not describe each and every limitation of these claims. Each of the subsisting claims 11, 13-16, 19-25 and 28-37 depends directly or indirectly from claim 9, 10 or 12 as amended. Each subsisting claim thus also includes the limitations set forth in the claim from which it depends (i.e., either claim 9, 10, or 12). The

basis of the rejection has thus been addressed. Reconsideration of the claims and withdrawal of the rejection under section 102(b) over Satani is respectfully requested.

IV. Claim rejection under 35 USC § 103(a)

Claims 17-18 and 26-27 are rejected under 35 U.S.C. 103(a) as being obvious over Satani in view of Ueyama et al. (U.S. patent 6,699,549) ("Ueyama"). Applicants respectfully traverse.

Regarding claim 17, the Examiner acknowledges that Satani does not teach layers further comprising liquid paraffin. The Examiner relies on Ueyama to cure this deficiency. Regarding claims 18, 26 and 27, the Examiner asserts that Satani teaches a laminate of three or more layers and teaches two surface layers and one intermediate layer. The Examiner contends that it would have been obvious to one of ordinary skill in the art to rearrange the two surface layers and one intermediate layer of Satani, and add two layers to reach the claimed 5-layer film.

As a first matter, Applicants note that the subject matter of claims 18, 26 and 27 have been folded into independent claims 9, 10 and 12, respectively.

In order to establish a prima facie case of obviousness, the combination of prior art must teach or suggest every limitation of the rejected claims. As explained more fully below, Satani actually teaches away from Surface layer (I), and does not teach Intermediate layer (III) of the instant claims.

First, the instantly claimed film must have a surface layer that contains, at a minimum, a mixed resin of a cyclic olefin series resin and a polyethylene series resin (A) in a mass ratio of 90/10 to 50/50. Thus, the instantly claimed film must have a surface layer that contains at least 10% polyethylene resin. Satani instructs that a surface layer that contains both cyclic olefin and polyethylene should not have more than 5% polyethylene, and thus teaches away from the recited surface layer. The Examiner asserts that Satani at page 4, lines 7-10 teaches a surface layer having cyclic olefin mixed with polyethylene, and that Satani at page 6, lines 41-46 teaches that the cyclic olefin component can occupy 80% of the surface layer, with the polyethylene component making up the remaining 20%. However, the Examiner has, in Applicants' opinion, misread Satani. If the

Examiner had read the passages at pages 4 and 6 (Comparative Example 2) in their entirety, it would have been clear that Satani **actually teaches away from cyclic olefin/polyethylene-containing surface layers that contain more than 5% polyethylene resin.** First, Satani at page 4, continues the passage cited by the Examiner by stating that “[f]or example, polyethylene resin can be mixed in an amount of 5% by weight or less. If the resin is more than 5% by weight, the solvent sealing property decreases, which is not desirable.” (See Satani at page 4, lines 10-11). Moreover, the film taught in Satani at page 6, lines 41-46 (Comparative Example 2) was used solely to show that films having surface layers containing cyclic olefin and more than 5% polyethylene “the films of Comparative Example ... 2 have a low ability for solvent sealing.” (See Satani at page 8, lines 27-28; see also page 8, Table 2). Thus, Satani teaches away from films having surface layers such as those of the instantly claimed invention. Put another way, one of ordinary skill in the art, when seeking a heat-shrinkable polyolefin film having surface layers containing cyclic olefin and more polyethylene and having suitable ability for solvent sealing, would not look to the cyclic olefin/polyethylene-containing surface layers taught in Satani, because they have more than 5% polyethylene and thus have a low ability for solvent sealing.

Satani does not teach Intermediate layer (III) of the instant claims. Intermediate layer (III) contains cyclic olefin as the main component (claim 9), or cyclic olefin resin plus polyethylene resin in a ratio of 95/5 to 50/50 (cyclic olefin/polyethylene) (claim 10) or a ratio of 90/10 to 60/40 (cyclic olefin/polyethylene) (claim 11). Thus, the Intermediate layer (III) component of the instantly claimed invention contains cyclic olefin resin and may contain cyclic olefin resin plus polyethylene resin, but never contains polyethylene resin as the **main** component (i.e., more than 50% polyethylene). The only intermediate layer taught in Satani contains polyethylene as the **main** component. (See Satani at page 2, lines 47-48.) According to the Satani specification, intermediate layers composed of resin materials containing a polyethylene resin as a main component ensure[] a low specific gravity and transparency in the film while ensuring high heat shrinkability. (See *id.*, page 3, lines 18-20). Thus, Satani does not teach or suggest the claimed Intermediate layer, either.

Thus, as regards claims 9, 10 and 12 (which incorporate the subject matter of now-canceled claims 18, 26 and 27), one of ordinary skill in the art could not employ the teachings of Satani to arrive at the claimed invention.

Claim 17 ultimately depends from claim 9 (through claim 16). Thus, claim 17 contains each and every limitation of claim 9, including the limitations relating Surface layer (I) and Intermediate layer (III) discussed above. The Examiner relies on Ueyama to teach film layers further comprising liquid paraffin. However, it is of no import whether Ueyama teaches or suggests liquid paraffin-containing alters or not, because, Ueyama cannot cure the deficiencies of Satani that relate to Surface layer (I) and Intermediate layer (III). Thus, claim 17 is not obvious over Satani in view of Ueyama.

Thus, for at least the reasons stated above, claims 9, 10, 12 (which, as stated above, incorporate the subject matter of now-canceled claims 18, 26 and 27, respectively) are not obvious over Satani, and claim 17 is not obvious over Satani in view of Ueyama, and the obviousness rejections should be withdrawn.

V. Conclusion

This application is believed to be in condition for allowance, which is earnestly solicited. If the Examiner believes there are further issues that could be advance by an interview or entry of an Examiner's Amendment, the Examiner is invited to contact the undersigned attorney.

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Respectfully submitted,

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